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09/750,001	12/29/2000	Scott M. Frank	BS00-428	6605

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EXAMINER	
OUELLETTE, JONATHAN P	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/750,001	FRANK ET AL.	
	Examiner	Art Unit	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *53-109* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *53-109* is/are rejected.

7)☐ Claim(s) *53,64,75,86,92 and 98* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Claims 1-52 have been cancelled and Claims 53-109 have been added; therefore Claims 53-109 are currently pending in application 09/750,001.

Priority

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional applications (60/173919, 60/192862) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claim 53, 64, 75, 86, 92, and 98 of this application. The provisional applications fail to disclose "tracking data related to a plurality of *non-monetary* innovation awards." The provisional applications also fail to disclose "determining participation data for each of a plurality of innovator classes."

Claim Objections

3. Claims 53, 64, 75, 86, 92, and 98 are objected to, because the applicant fails to distinctly reference where the specification supports the newly amended/added claims.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. The rejection of Claims 1, 17, 24, 50, and 52 under 35 U.S.C. 101 is withdrawn due to the Applicant's cancellation of the rejected claims.

6. **Claims 53-63, 75-91, 98-104, 106, 107, and 109 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

7. The basis of this rejection is set forth in a two-prong test of:

   (1) whether the invention is within the technological arts; and

   (2) whether the invention produces a useful, concrete, and tangible result.

8. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

9. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

10. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson,* 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

11. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found

that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

12. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.,* the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma.* However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed

invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

13. Claims 75-85, 98-103, 106, and 109 appear to be a process that is attempting to sell an innovation tracking/reward tracking service. Thus, this process does not include a distinguishable apparatus, computer implementation, or any other incorporated technology, and would appear to be an attempt to patent an abstract idea not a "tangible" process and, therefore, non-statutory subject matter.

14. Claims 53-63, 86-91, 104, and 107 appear to be a process containing a computer program, without the computer-readable medium needed to realize the computer program's functionality. Thus, this process does not include a distinguishable apparatus, computer implementation, or any other incorporated technology, and would appear to be an attempt to patent an abstract idea not a "tangible" process and, therefore, non-statutory subject matter (MPEP 2106).

Claim Rejections - 35 USC § 112

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 108 and 109 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Claims 108 and 109 recite the limitation "the program" in apparatus claim 92 and method claim 98. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

19. **Claims 86, 92, 98, and 107-109 are rejected under 35 U.S.C. 102(e) as being anticipated by Powell (US 2004/0220881 A1).**

20. As per **independent Claims 86, 92, and 98**, Powell discloses a method for tracking innovation disclosures by an organization, comprising the steps of: receiving data associated with a plurality of innovation disclosures, each innovation disclosure associated with an intellectual property asset and one of a plurality of innovators (Para 0108-0125, originator database and FDI database); and determining participation data for each of a plurality of innovator classes (Para 0109, type of originator).

21. As per Claims 107, 108, and 109, Powell discloses determining participation data for each of a plurality of innovator classes, so that participation rates can be effectively tracked and managed.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

23. The rejection of Claims 1-52 under 35 U.S.C. 103(a) as being unpatentable over Asplen, Jr. (US 6,044,354), in view of Harshaw (US 6,542,871) is withdrawn due to the Applicant's cancellation of the rejected claims.

24. **Claims 53, 54, 58, 64, 65, 69, 75, 76, 80, and 104-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell (US 2004/0220881 A1) in view of Eggleston et al. (US 6,061,660).**

25. As per **independent Claims 53, 64, and 75**, Powell discloses a method for tracking innovations, comprising the steps of: receiving data related to a plurality of innovation disclosures, each innovation disclosure associated with an intellectual property asset and one of a plurality of innovators (Para 0088; Para 0108-0125, originator database and FDI database).

26. While Powell does disclose tracking innovation incentives/payment, Powell fails to expressly disclose tracking data related to a plurality of non-monetary innovation awards, each innovation award associated with at least one of the innovation submissions.

27. Eggleston discloses the creation of employee incentive programs, which include tracking/automated fulfillment of non-monetary reward distribution data (Fig.20, C8 L13-20, C31 L25-67, C32 L1-20).

28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included tracking data related to a plurality of non-monetary innovation awards, each innovation award associated with at least one of the innovation submissions, as disclosed by Eggleston in the system disclosed by Powell, for the advantage of providing a method for tracking innovations awards with the ability to increase effectiveness of the system by offering/tracking a multitude of award types.

29. As per Claims 54, 65, and 76, Powell and Eggleston disclose wherein the tracking step further comprises: tracking the distribution of one of a plurality of gifts given to one of the plurality of innovators as the non-monetary innovation award.

30. As per Claims 58, 69, and 80, Powell and Eggleston disclose wherein the tracking step further comprises: generate a form letter (coupon sheet, points announcement) associated with one of the innovation awards.

31. As per Claims 104, 105, and 106, Powell and Eggleston disclose tracking data related to a plurality of non-monetary innovation awards, each innovation award associated with at least one of the innovation submissions, so that award costs and inventory can be effectively tracked and managed.

32. **Claims 55-57, 59-63, 66-68, 70-74, 77-79, and 81-85 are rejected under 35 U.S.C. 103 as being unpatentable over Powell in view of Eggleston.**

33. As per Claims 55-56, 66-67, and 77-78, while Eggleston does disclose tracking data associated with each of a plurality of gifts (Fig.20, C8 L13-20, C31 L25-67, C32 L1-20), Powell and Eggleston fail to expressly disclose wherein the data includes at least one of cost and supplier, quantity in stock.

34. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation awards would be performed regardless of the type of award/gift data tracked. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

35. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have tracked a plurality of award/gift data to include: included a plurality of innovator classes, to include: cost and supplier, quantity in stock, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

36. As per Claims 57, 60-63, 68, 71-74, 79, and 82-85, Powell and Eggleston fail to expressly disclose tracking the number of innovation disclosures processed during the specific time period, data associated with an innovation award distributed upon submission of the innovation disclosure associated with the innovation award, data associated with an innovation award distributed upon issuance of the intellectual property asset associated with the innovation award, an innovation award distributed upon publication of data described in the innovation disclosure, and/or data associated with an

innovation award distributed upon publication of data described in the innovation disclosure.

37. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation awards would be performed regardless of the type of innovation information was tracked. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

38. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have tracked a plurality of innovation associated information, to include: the number of innovation disclosures processed during the specific time period, data associated with an innovation award distributed upon submission of the innovation disclosure associated with the innovation award, data associated with an innovation award distributed upon issuance of the intellectual property asset associated with the innovation award, an innovation award distributed upon publication of data described in the innovation disclosure, and/or data associated with an innovation award distributed upon publication of data described in the innovation disclosure, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

39. As per Claims 59, 70, and 81, Powell and Eggleston fail to expressly disclose storing IP coordinator contact data, the IP coordinator associated with an innovator.

40. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation awards would be performed regardless of the type of innovation information was stored. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

41. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have stored a plurality of innovation associated information, to include: innovator associated IP coordinator contact data, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

42. **Claims 87-91, 93-97, and 99-103 are rejected under 35 U.S.C. 103 as being unpatentable over Powell.**

43. As per Claims 87-90, 93-96, and 99-102, Powell does not expressly show wherein the plurality of innovator classes includes the class of employees of the organization, the class of non-employees of the organization, or the class of contractors of the organization.

44. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation disclosures by an organization would be performed regardless of the type of innovator class used. Thus, this descriptive data will not distinguish the claimed invention from the

prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

45. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a plurality of innovator classes, to include: the class of employees of the organization, the class of non-employees of the organization, or the class of contractors of the organization, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

46. As per Claims 91, 97, and 103, while Powell does disclose storing organization data associated with the innovator (Para0109, type of originator), Powell does not expressly show the organization data related to the innovator and including at least one of affiliate organization, company, division, and business unit.

47. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation disclosures by an organization would be performed regardless of the type of innovator descriptive data used. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

48. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a innovator descriptive data (organization al date) to include: at least one of affiliate organization, company, division, and business unit,

because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Response to Arguments

49. Applicant's arguments filed 2/22/05 have been considered, but are moot in view of the new ground(s) of rejection.

50. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

51. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

52. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-

6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

53. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.

54. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

jo
May 25, 2005

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600